

Notice of Allowability

Application No.

10/771,725

Examiner

Zachary C. Tucker

Applicant(s)

THURIEAU ET AL.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 6 March 2007.
2. ☒ The allowed claim(s) is/are 9, 11, 30, 34 and 35.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892) 14 PAGES
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with applicants' counsel Tony K. Uhm, on 26 March 2007.

IN THE CLAIMS -

Claim 34 has been amended thus:

34. A method of treating acromegaly, restenosis, Crohn's disease, systemic sclerosis, external and internal pancreatic pseudocysts and ascites, VIPoma, nesidoblastosis, hyperinsulinism, gastrinoma, Zollinger-Ellison Syndrome, diarrhea, AIDS related diarrhea, chemotherapy related diarrhea, scleroderma, Irritable Bowel Syndrome, pancreatitis, small bowel obstruction, gastroesophageal reflux, duodenogastric reflux, Cushing's Syndrome, hyperparathyroidism, Graves' Disease, diabetic neuropathy, Paget's disease, polycystic ovary disease, ~~cancer, cancer-cachexia~~, postprandial hypotension, hypotension, panic attacks, GH secreting adenomas or TSH secreting adenomas, in a subject in need thereof, which comprises administering a compound according to claim 9 or a pharmaceutically acceptable salt thereof to said subject.

end of amendment

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Response to Amendment

As requested by applicants, in the correspondence filed 6 March 2007 (hereinafter "present amendment"), which is in reply to the Final Rejection mailed 6 December 2006 (hereinafter "Final Rejection"), claims 9, 30, 34 and 35 have been amended while claims 1, 5-8, 12-20, 31-33 and 36 have been cancelled. The specification has been amended by deletion of the paragraph starting at page 1, line 20, also as requested in the correspondence from applicants.

Election/Restrictions

Because the invention elected for examination, Group I (claims 1-30) is now in condition for allowance pursuant to the present amendment, the claims of nonelected Group II (claims 31-43), drawn to a methods of treating diseases and medical conditions comprising administering a product as provided for in Group I to a subject in need thereof. All of the claims originally present in Groups I and II are no longer pending, due to amendments to the claims, however. Group I now consists only of claims 9 and 11, and Group II now consists only of claims 30, 34 and 35.

The Requirement for Restriction between Groups I and II, as was set forth in the Office letter mailed to applicants on 14 September 2004, is hereby WITHDRAWN.

Status of Claim Rejections - 35 USC § 112

Claim 1 was rejected in the Final Rejection, under 35 U.S.C. 112, first paragraph, for incorporation of new matter. Specifically, it was noted that the proviso added to claim 1 by the amendment filed 10 October 2006, which excluded a single chemical compound, established a relationship between the variables in formula (I) that was not described in the claims or specification as originally filed.

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In view of the present amendment, which cancels instant claim 1, the rejection is now effectively moot.

Status of Claim Rejections - 35 USC § 102

Claim 1 was rejected in the Final Rejection, under 35 U.S.C. 102(b), as being anticipated by WO 95/08550 (von Geldern et al 1995).

In view of the present amendment, which cancels instant claim 1, the rejection is now effectively moot.

Specification

In the Final Rejection, the specification was objected to for incorporation of new matter.

The amendment filed 10 October 2006 added a passage to the specification in which activity of the compounds of the present invention was correlated with various indications for treatment of diseases and medical conditions, as said indications are described in various publications, both non-patent and patent. This information was not in the specification as originally filed, and thus was deemed new matter.

Objection to the specification is hereby withdrawn in view of the present amendment, which deletes the material added pursuant to the amendment filed 10 October 2006.

Allowable Subject Matter

Claims 9,11,30,34 and 35 are allowed.

Reasons for allowance were provided at pages 8 and 9 of the Final Rejection von Geldern et al, von Geldern et al 1995, and Gordon et al, all of record, are the closest prior art.

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The methods of allowed claims 34 and 35 are enabled by the disclosure, for reasons provided in the Final Rejection (page 8 and 9), and also for reasons provided on page 5 of the Non-Final Rejection mailed on 27 April 2006.

As a courtesy to applicants, the 57 references cited in the passage (which is now deleted) added to the specification in the amendment filed 10 October 2006 have been cited by the examiner on a PTO-892 form, so that all of these references will be cited on the face of the printed patent issuing from this application.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Conclusion

All Post-Allowance Correspondence concerning this application must be mailed to:

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.



ZACHARY C. TUCKER
PRIMARY EXAMINER